

Appl. No. 10/071,938
RCE Submission dated Jan. 26, 2006
Reply to Final Office Action of Oct. 26, 2005

REMARKS/ARGUMENTS

1. The Examiner rejected claims 26-34 and 40-50 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 26-34 and 40-50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lehtiniemi et al. (U.S. Patent No. 6,466,299). Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein.

Rejections under 35 U.S.C. § 112, first paragraph

2. Claims 26-34 and 40-50 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner asserts that the production of a “non-visual” sensation by the claimed sensory producing substance is not enabled and the introduction of such a term into the claims may be new matter. Applicants respectfully disagree.

Applicants clearly state, at various locations of the originally filed specification, that the sensory producing substance can produce visual and/or non-visual sensations. For example, on page 6, lines 6-13 Applicants state that:

When the appearance changing substance is a *sensory producing substance*, it can be a *thermal* producing substance, a *vibration* producing substance, and a *haptic* producing substance, or any combination therein. For example, the appearance changing substance can cause the housing 12 to interact with the muscles and tendons that give the human a sensation of a force being applied. Similarly, the housing 12 can interact with the nerve endings in the skin that indicate *heat, pressure, and texture*. It will be appreciated by one of ordinary skill in the art that the sensory producing substance can be any of those substances mentioned herein or an equivalent.

(Emphasis added.)

Applicants further state, on page 10, line 19 through page 11, line 7, that the appearance changing substance as originally claimed can produce visual (e.g., color, pattern, illumination, and/or shape) and/or *non-visual* (e.g., thermal, vibration, and/or haptic) sensations. In particular, on page 10, lines 20-23, Applicants state that the appearance changing substance can be “a color changing substance, a pattern changing substance, an illumination producing substance, a shape changing substance, and a *sensory producing substance*.” (Emphasis added.) Applicants go on

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to further state, at page 10, line 23 through page 11, line 2, that “[i]t will be appreciated by one of ordinary skill in the art that the appearance changing substance can be any of those substances mentioned herein or an equivalent.”

On page 11, lines 3-5 of the originally filed specification, Applicants also state that the *sensory producing substance* can be “a thermal producing substance, a vibration producing substance, and a haptic producing substance, or any combination [thereof].” Applicants go on to further state, at page 11, lines 5-7, that “[i]t will be appreciated by one of ordinary skill in the art that the sensory producing substance can be any of those substances mentioned herein or an equivalent.”

As is clear from the foregoing excerpts of Applicants’ specification, Applicants have clearly advised those of ordinary skill in the art that the sensory producing substance can produce a *non-visual* sensation. Moreover, independent claims 26, 29, and 32 of the elected invention used the term “sensory producing substance” in the original filing thereof as part of Applicants’ first RCE dated February 10, 2005, and Applicants clearly directed the Examiner’s attention therein to page 6, lines 6-13, page 10, line 19 through page 11, line 7, and other areas of the specification in order to evidence support for use of such term in the claims that are presently under examination.

In order to make a rejection under 35 U.S.C. § 112, first paragraph, based on an alleged lack of an enablement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04. The test for enablement is whether the claimed invention has been described in such a way that any person skilled in the art can make and use the invention *without undue experimentation*. M.P.E.P. § 2164.01 (emphasis added). The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination. M.P.E.P. § 2164.01(a). Rather, it is a conclusion reached by weighing all of the following factual considerations:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;

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- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988).

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. M.P.E.P. § 2164.01(a). The Examiner's analysis *must* consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. *Id.* (emphasis added).

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms *which correspond in scope* to those used in describing and defining the subject matter sought to be patented *must* be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. M.P.E.P. § 2164.04 (emphasis added). As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112, first paragraph, is satisfied.

While Applicants have not expressly used the term "non-visual" in the specification, such express use is not necessary in order to have an enabling disclosure so long as the term used in the claims corresponds *in scope* to the disclosed manner of making and using the invention. M.P.E.P. § 2164.04. In the present case, Applicants use of the term "non-visual" in the claims is within the scope of the manner of making and using the invention described in the specification. Applicants provide examples in their specification of various "non-visual" sensations that may be produced by the recited "sensory producing substance." The examples of thermal, vibration and haptic sensations are all *non-visual*. As a result, Applicants have enabled those of ordinary skill in the art to make and used the claimed invention and the claimed subject matter is not new matter. Moreover, the Examiner has failed to make a *prima facie* case of non-enablement

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because the Examiner has failed to consider *any* of the undue experimentation factors set forth in *In re Wands* as required under M.P.E.P. § 2164.01(a).

Based on the foregoing, Applicants submit that the Examiner has not established a reasonable basis to question the enablement of Applicants' invention as required under M.P.E.P. § 2164.04 and respectfully request that the rejection of claims 26-34 and 40-50 under 35 U.S.C. § 112, first paragraph, be withdrawn.

In connection with the present submission, Applicants have added the term "non-thermal" to the pending independent claims. Such term is also supported by Applicants specification at least at those locations listed above which provide examples as to the types of "sensory producing substances" contemplated by Applicants' invention. While Applicants specification lists a thermal producing substance as one possible form of sensory producing substance, Applicants also list various other sensory producing substances that are both *non-visual* and *non-thermal*, such as a vibration producing substance, a haptic producing substance (which is limited to being non-thermal by the newly introduced claim language), and/or a substance that produces a pressure or texture sensation. (See page 6, lines 6-13 of Applicants' specification.) As a result, the term "non-thermal, non-visual" as now recited in Applicants' claims is fully supported by Applicants' originally filed specification.

Rejections under 35 U.S.C. § 102(e)

3. Claims 26-34 and 40-50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lehtiniemi et al. ("Lehtiniemi"). Applicants have herein amended independent claims 26, 29, 32, 34, and 40 to more clearly distinguish the recitations of said claims from the disclosure and suggestions of Lehtiniemi. In particular, Applicants have included the limitation that the outer surface of the housing, or a portion thereof (e.g., one or more shape elements included therewith or attached thereto), includes a sensory producing substance that produces at least one *non-thermal, non-visual* sensation responsive to at least one stimulus. Applicants submit that none of the references of record discloses or suggests such a limitation.

"A claim is anticipated only if *each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

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1053 (Fed. Cir. 1987)). As detailed below, Lehtiniemi fails to expressly or inherently describe each and every claim limitation of Applicants' claims.

Lehtiniemi discloses a portable electronic device housing coated or mixed to include thermochromic liquid crystals (TLCs) that change color responsive to changes in temperature. The changes in temperature may be due to changes in ambient temperature of the environmental surroundings of the portable electronic device or may be due to the internal heating of the electronic components of the portable electronic device. *See Abstract, col. 1, lines 58-67.* Thus, Lehtiniemi discloses only that a portable electronic device housing, or some portion thereof, changes color (i.e., makes a *visual* change) responsive to changes in temperature. While Applicants believe that Lehtiniemi fails to disclose or suggest any *non-visual or other sensory* changes to the device housing, or production of any *non-visual or other sensations*, responsive to temperature changes or any other stimulus, the Examiner appears to be asserting (although it is never expressly stated in the Office Action), based upon the Examiner's almost exclusive reliance on col. 1, lines 58-67, that Lehtiniemi's housing produces a thermal sensation as the housing heats up. While Applicants disagree with the Examiner's suggestion, Applicants have nevertheless amended the claims of the present application to move prosecution forward.

Applicants have further considered Laurikka et al. (U.S. Patent No. 6,608,996) and Berry (U.S. Patent No. 5,223,958), both already of record, and submit that both references, like Lehtiniemi, fail to disclose or suggest any *non-thermal, non-visual* changes to the device housing, or production of *any non-thermal, non-visual sensations*, responsive to temperature changes or any other stimulus. Rather, Laurikka et al. ("Laurikka") discloses only that the electronic device housing, or portion(s) thereof, changes color (i.e., a *visual* change) in response to a variety of stimuli, including the type of message that has been received by the device. Berry discloses only that a hidden message appears (i.e., a *visual* change) in response to a thermal stimulus.

By contrast, Applicants' independent claims, as amended, recite housings that include a sensory producing substance that produces at least one *non-thermal, non-visual* sensation responsive to one or more stimuli. As recited in some of the dependent claims, the non-thermal, non-visual sensation produced by the sensory producing substance may be a haptic sensation (i.e., relating to one's sense of touch), such as a texture sensation, a pressure sensation, and/or a

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vibratory sensation. Neither Lehtiniemi nor Laurikka, Berry or any of the other references of record disclose or suggest any housing containing a substance that produces a *non-thermal, non-visual* sensation responsive to a stimulus.

The Examiner asserts that Lehtiniemi discloses that the housing's sensory producing substance is one or more of a thermal producing substance, a vibration producing substance and a haptic producing substance. In support of his position, the Examiner directs Applicants' attention to column 1, lines 58-67 of Lehtiniemi. Applicants submit that neither the cited portion of Lehtiniemi nor any other portion of Lehtiniemi discloses or even remotely suggests any change to the cover or production of any sensation other than a visual sensation related to a change of color. As is clear from a careful reading of Lehtiniemi, including the disclosure at column 1, lines 58-67, Lehtiniemi discloses a housing substance that changes color responsive to changes in temperature. Lehtiniemi does not disclose or suggest a housing that produces any other type of sensation. Neither Lehtiniemi nor any of the cited references of record disclose or even remotely suggest the use of any substance that produces any haptic (i.e., touch related) sensation responsive to any form of stimulus. Rather, all of the references of record disclose substances that produce specific *visual* sensations responsive to thermal and other specific stimuli.

Therefore, based on the foregoing, Applicants submit that independent claims 26, 29, 32, 34, and 40 are not anticipated by Lehtiniemi and respectfully request that the rejections of claims 26, 29, 32, 34, and 40 be withdrawn and said claims be passed to allowance.

Claims 27, 28, 30, 31, 33, and 41-50 are dependent upon claims 26, 29, 32, and 40, which claims have been shown allowable above. Therefore, since claims 27, 28, 30, 31, 33, and 41-50 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicants respectfully submit that the recitations of claims 27, 28, 30, 31, 33, and 41-50 are not disclosed or suggested by Lehtiniemi. Further, with respect to claims 27, 30, 49, and 50, neither Lehtiniemi nor any of the other references of record disclose a housing that includes a haptic producing substance. Still further, with respect to claims 28, 31, and 47, none of the references of record disclose a housing that includes a substance that produces at least one of a vibration, a pressure sensation, and a texture sensation. Further yet, with respect to claims 33, 41, 44, and 48, none of the references

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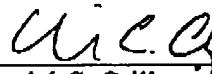
of record disclose a housing that includes a substance that produces a *non-thermal, non-visual* sensation responsive to an acoustic stimulus, an electromagnetic stimulus, an olfactory stimulus, or a mechanical stimulus. Instead, all the references of record simply disclose housings that include *visual* producing substances only. Therefore, Applicants respectfully submit that claims 27, 28, 30, 31, 33, and 41-50 are in proper condition for allowance.

Other Amendments to the Claims

4. Applicants have herein amended some of the claims to correct minor informalities therein and make the recitations of dependent claims consistent with amendments made to their respective base claims. None of these amendments were intended to narrow the claims in any manner or were made for any purpose related to patentability. Applicants submit that all such claim amendments are fully supported by Applicants' originally filed specification.

5. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

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